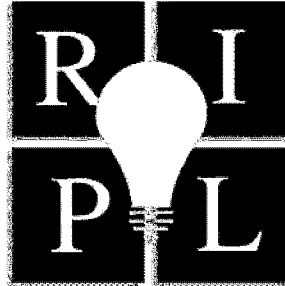


THE JOHN MARSHALL REVIEW OF INTELLECTUAL PROPERTY LAW



GONNA WASH THAT RIGHT OF PUBLICITY RIGHT OUT OF MY HAIR – LIFE
AFTER *TONEY V. L'OREAL*

EDWIN F. MCPHERSON

ABSTRACT

There were very few problems with preemption of the state right of publicity by the Copyright Act; that is, until the Seventh Circuit changed everything in *Toney v. L'Oreal U.S.A., Inc.* This article focuses on the *Toney* case, the *Baltimore Orioles, Inc. v. Major League Baseball Players Association* case that spawned *Toney*, and the devastating effect the law from these cases will have on the right of publicity, the entertainment industry as a whole, and many other areas of civil and criminal law, if *Toney* is allowed to stand.

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AUTHOR'S NOTE

Subsequent to the preparation of this article, the Seventh Circuit was persuaded to reconsider its 2004 decision in *Toney v. L'Oreal U.S.A., Inc.*¹ After reconsideration—which included an analysis that was completely antithetical to its original decision—on May 6, 2005 the Seventh Circuit reversed the decision of the district court, and remanded the case for further proceedings.² That the same judges of the same circuit reversed their own decision so decisively is as bizarre as the nature of the original opinion; however, it is certainly more in line with reality and the law in other circuits.

Essentially, the court contradicted the premise of its original decision (which was based upon the *Baltimore Orioles* case³); i.e., that an individual's *persona* is fixed in a tangible medium of expression, and essentially that anything that is fixed in a tangible medium of expression is preempted by Federal copyright law.⁴ In *Baltimore Orioles*, the court had earlier summarily dismissed all of the decisions from the Second and Ninth Circuits as having been “premised upon an erroneous analysis of preemption,” and responded to both circuits' determinations by saying simply: “[w]e disagree,” indicating that “a performance is fixed in tangible form when it is recorded.”⁵

In the new decision, the court suddenly finds that “Toney's identity is not fixed in a tangible medium of expression,” and that there “is no ‘work of authorship’ at issue in Toney's right of publicity claim. A person's likeness—her *persona*—is not authored and it is not fixed. The fact that an image of the person might be fixed in a copyrightable photograph does not change this.”⁶ The court went on to say that, as a result, the rights protected by the IRPA are not equivalent to the exclusive rights protected by the Copyright Act.⁷

Finally, under the heading “*C. Conflicting Precedent*,” the court “clarified” its holding in *Baltimore Orioles*, which it acknowledged has been “widely criticized by

* Edwin F. McPherson is a partner at McPherson & Kalmansohn, LLP in Los Angeles, Cal., specializing in entertainment and intellectual property litigation. Asha Dhillon, whose valuable assistance and research for this article is acknowledged and appreciated, is an associate at the firm. McPherson & Kalmansohn, LLC has litigated numerous right-of-publicity and copyright cases through trial and appeal.

¹ *Toney v. L'Oreal U.S.A., Inc.*, 384 F.3d 486 (7th Cir. 2004), *reh'g en banc granted*, No. 03-2184, 2005 U.S. App. Lexis 1943 (Feb. 3, 2005), *rev'd*, No. 03-2184, 2005 U.S. App. LEXIS 7897 (May 6, 2005).

² *See Toney v. L'Oreal U.S.A., Inc.*, No. 03-2184, 2005 U.S. App. LEXIS 7897 (7th Cir. May 6, 2005).

³ *Balt. Orioles v. Major League Baseball Players Ass'n*, 805 F.2d 663 (7th Cir. 1986).

⁴ *See Toney*, 384 F.3d at 489–92.

⁵ *Balt. Orioles*, 805 F.2d at 677 n.26.

⁶ *Toney*, 2005 U.S. App. LEXIS 7897, at *11.

⁷ *Id.*

our sister circuits and by several commentators.”⁸ The court stated that the case does not stand for the proposition that the right of publicity is preempted in all instances; “it does not sweep that broadly.”⁹

The court went on to say that *Baltimore Orioles* itself makes clear that “[a] player’s right of publicity in his name or likeness would not be preempted if a company, without the consent of the player, used the player’s name to advertise its product.’ Therefore, the bottom line is that Toney’s claim under the Illinois right of publicity statutes is not preempted by federal copyright law.”¹⁰ In its original opinion, the court stated that, although “a casual reading” of that language appears to support Toney’s position that her likeness is not within the subject matter of copyright, and that, therefore, the plaintiff’s right of publicity claim is not preempted, “Toney is mistaken.”¹¹

Right-of-publicity law in the Seventh Circuit is still anything but clear.

INTRODUCTION

Traditionally, common law and statutory state law rights of publicity peacefully coexisted with the Copyright Act. Because the right of publicity involves different primary rights (and generally different rights holders than those protected by copyright laws), there were very few problems with preemption of the state right of publicity by the Copyright Act; that is, until the Seventh Circuit changed everything in *Toney v. L’Oreal U.S.A., Inc.*¹²

This article focuses on the *Toney* case, the *Baltimore Orioles, Inc. v. Major League Baseball Players Association* (“*Baltimore Orioles*”)¹³ case that spawned *Toney*, and the devastating effect the law from these cases will have on the right of publicity, the entertainment industry as a whole, and many other areas of civil and criminal law, if *Toney* is allowed to stand.

I. THE ORIGIN OF THE RIGHT OF PUBLICITY

The right of publicity is one of four separate torts identified by Prosser that embody the broader tort of right of privacy.¹⁴ Those torts include: (i) intrusion by physical invasion of one’s premises, or by wiretapping or bugging; (ii) placing the plaintiff before the public in a “false light” (*i.e.*, defamation); (iii) public disclosure of

⁸ See *id.* at *12–*14.

⁹ *Id.* at *13.

¹⁰ *Id.* at *13–*14 (quoting *Balt. Orioles*, 805 F.2d at 666 n.24) (citation omitted).

¹¹ *Toney v. L’Oreal U.S.A., Inc.*, 384 F.3d 486, 490 (7th Cir. 2004), *reh’g en banc granted*, No. 03-2184, 2005 U.S. App. Lexis 1943 (Feb. 3, 2005), *rev’d*, No. 03-2184, 2005 U.S. App. LEXIS 7897 (May 6, 2005).

¹² *Id.*

¹³ *Balt. Orioles*, 805 F.2d 663.

¹⁴ W. Prosser, *Privacy*, 48 CAL. L. REV. 383, 386 (1960).

private facts about the plaintiff; and (iv) misappropriation of the plaintiff's name or likeness for commercial purposes.¹⁵

Although Prosser described the right of privacy in his law review article and his treatise¹⁶ as recently as 1984, the tort is much older than that. The right of privacy has been described alternatively as “the privilege to live a life free from unwarranted publicity,”¹⁷ the “right of a person and the person's property to be free from unwarranted public scrutiny or exposure,”¹⁸ and simply the right “to be let alone.”¹⁹

The first state to enact a statute to protect the right of privacy was New York in 1903 in response to the New York Appellate Court's decision in *Roberson v. Rochester Folding Box Co.*, which held that the right of privacy did not exist.²⁰ The new statute prohibited, among other things, the use of a person's “name, portrait, or picture” for advertising purposes or for purposes of trade without that person's consent.²¹ This statute became the model for name and likeness statutes in many states.²²

Although Prosser and others describe the right of publicity as a category of the privacy tort, the modern approach is to consider them two separate and distinct torts. The right of publicity was developed primarily for public figures thought to have voluntarily given up much of their right of privacy.²³ As noted by J. Thomas McCarthy: “famous plaintiffs’ began to appear in court to complain that their identity was used in advertising without their permission. Their complaint sounded out of tune with the concept of ‘privacy.’”²⁴ McCarthy continues: “Their complaint was not that they wanted no one to commercialize their identity, but rather that they wanted the right to control when, where and how their identity was so used. Their

¹⁵ *Id.* Black's Law Dictionary defines “right of publicity” as the “right to control the use of one's own name, picture, or likeness and to prevent another from using it for commercial benefit without one's consent.” BLACK'S LAW DICTIONARY 1325 (7th ed. 1999).

¹⁶ W. PAGE KEETON ET AL., PROSSER AND KEETON ON THE LAW OF TORTS 849–69 (5th ed. 1984).

¹⁷ Prosser, *supra* note 14, at 386.

¹⁸ BLACK'S LAW DICTIONARY, *supra* note 15, at 1325.

¹⁹ THOMAS COOLEY, LAW OF TORTS 29 (2d ed. 1888); RESTATEMENT (SECOND) OF TORTS § 652A cmt. a (1976).

²⁰ *Roberson v. Rochester Folding Box Co.*, 64 N.E. 442, 447 (N.Y. 1902).

²¹ 1903 N.Y. Laws 132 1–2 (codified as amended in N.Y. CIV. RIGHTS LAW §§ 50, 51 (2000)).

²² Such statutes exist in at least seventeen states, including New York, California, Florida, Illinois, Kentucky, Ohio, Texas, Wisconsin, Indiana, Massachusetts, Nebraska, Nevada, Oklahoma, Rhode Island, Tennessee, Virginia, and Washington. In addition, eighteen states recognize a common law right of publicity, including Arizona, Alabama, California, Connecticut, Florida, Georgia, Hawaii, Illinois, Kentucky, Michigan, Minnesota, Missouri, New Jersey, Ohio, Pennsylvania, Texas, Utah, and Wisconsin. Meanwhile, twenty-eight states have recognized the right to publicity either under statute or common law. *Bosley v. Wildwett.com*, 310 F. Supp. 2d 914, 935 (N.D. Ohio 2004). Only Nebraska and New York expressly rejected a common law right to publicity, but both of those states later recognized a right to publicity with statutory enactments. 1 J. THOMAS MCCARTHY, THE RIGHTS OF PUBLICITY AND PRIVACY §§ 6:1–6:3 (2d ed. 2004). In fact, of the United States territories, only Puerto Rico currently rejects the right to publicity. *Guedes v. Martinez*, 131 F. Supp. 2d 272, 278 (D.P.R. 2001).

²³ Although this tort was originally developed as a remedy for celebrities who had had their identities misappropriated for commercial benefit, most states allow non-celebrities to sue for violations of rights of publicity, though by definition, such non-celebrities' damages will be much less.

²⁴ 1 MCCARTHY, *supra* note 22, § 1:7.

real complaint was to their ‘pocketbook,’ not to their ‘psyche.’”²⁵ As a result of the confusion from calling both torts “privacy” torts, Judge Jerome Frank coined the term “right of publicity” in *Haelan Lab, Inc. v. Topps Chewing Gum, Inc.*²⁶

The right of publicity is the right to protect one’s identity from misappropriation.²⁷ The damages for a violation of this right are generally measured by the commercial value of that identity, which is often determined by the fair market value that an advertiser would have had to pay to use that person as a spokesperson.²⁸ On the other hand, damages for a violation of one’s right of privacy are generally based on mental distress resulting from the intrusion into “a secluded and private life, free from the prying eyes and ears” of the public and the press.²⁹

Traditionally, the right of publicity was the right not to have one’s name or likeness used by an unauthorized third party to advertise a product. However, the right has been expanded to include one’s voice,³⁰ performance³¹ and race car number,³² and anything else that reasonably constitutes one’s persona.³³ In other words, in some instances one’s uniform or number or car is so closely associated with him or her that using a photograph of one of those objects to advertise a product is tantamount to using a photograph or other likeness of the individual.

In *Toney v. L’Oreal U.S.A., Inc.*,³⁴ the Seventh Circuit Court of Appeals affirmed the order of the Northern District of Illinois granting the defendants’ Rule 12(b)(6) motion to dismiss the plaintiff’s state law right of publicity claim. *Toney* held that the Copyright Act precludes such claims when the violation occurs through a medium that is protected by the Act.³⁵ In order to understand *Toney*, it is necessary to review the 1986 Seventh Circuit decision in *Baltimore Orioles*, which set the stage for *Toney*.³⁶

II. BALTIMORE ORIOLES, INC. V. MAJOR LEAGUE BASEBALL PLAYERS ASSOCIATION

After a long-standing debate between the Major League baseball clubs (“Clubs”) and the Major League Baseball Players Association (“Players”) as to who owned the rights to telecasts of games, the Clubs filed suit in federal district court in Chicago in

²⁵ *Id.*

²⁶ *Haelan Labs., Inc. v. Topps Chewing Gum, Inc.*, 202 F.2d 866, 868 (2nd Cir. 1953).

²⁷ See RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 4.49 cmt. d (1995).

²⁸ *Id.*

²⁹ RESTATEMENT (SECOND) OF TORTS § 652A cmt. b (1976); see also MCCARTHY, *supra* note 22, § 5:61.

³⁰ See *Midler v. Ford Motor Co.*, 849 F.2d 460, 463 (9th Cir. 1988); *Waits v. Frito Lay, Inc.*, 978 F.2d 1093, 1098 (9th Cir. 1992). For a detailed discussion of the tort of voice misappropriation, see Edwin McPherson, *Voice Misappropriation in California – Bette Midler, Tom Waits, and Grandma Burger*, 11 U. MIAMI BUS. L. REV. 43 (2003).

³¹ See *Zachini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 575–76 (1977).

³² See *Motschenbacher v. R. J. Reynolds Tobacco Co.*, 498 F.2d 821, 822, 827 (9th Cir. 1974).

³³ *Id.*; see also *Zachini*, 433 U.S. at 562.

³⁴ *Toney v. L’Oreal U.S.A., Inc.*, 384 F.3d 486, 490 (7th Cir. 2004), *reh’g en banc granted*, No. 03-2184, 2005 U.S. App. Lexis 1943 (Feb. 3, 2005), *rev’d*, No. 03-2184, 2005 U.S. App. LEXIS 7897 (May 6, 2005).

³⁵ *Id.*

³⁶ *Balt. Orioles, Inc. v. Major League Baseball Players Ass’n*, 805 F.2d 663 (7th Cir. 1986).

June of 1985, seeking a declaratory judgment that the Clubs owned the rights.³⁷ Immediately thereafter, three players filed suit against the Clubs in the Southern District of New York for misappropriation of their property rights in their names, pictures, and performances.³⁸ The parties stipulated to transfer the New York action to Chicago and to consolidate the actions.³⁹

Immediately after the transfer, the Clubs moved for summary judgment on their claims that they owned the exclusive rights to the telecasts based upon the “works made for hire” doctrine of copyright law⁴⁰ and state master-servant law. Their motion was granted by the District Court.⁴¹

The Seventh Circuit held that the Players were employees and that their performances were within the scope of their employment.⁴² The court also held that, unless the parties have expressly agreed otherwise in a written instrument signed by them (which the court found they did not do), the telecasts constituted works made for hire.⁴³

The Players claimed, irrespective of copyright ownership, the broadcast of the games without their express consent violated their rights of publicity in their performances.⁴⁴ They further argued that although the telecast did meet the preemption requirement of being “fixed in tangible form,” their performance was not fixed in tangible form.⁴⁵ The court determined that because the Players’ performances were embodied in a copy (the videotape of the telecast), those performances were fixed in tangible form. The court concluded, “any property rights in the performances that are equivalent to any of the rights encompassed in a copyright are preempted.”⁴⁶

The court acknowledged that unrecorded performances are subject to state right of publicity laws.⁴⁷ The court provided examples such as unfilmed choreography, an extemporaneous speech and an unrecorded or unwritten dramatic sketch or musical composition.⁴⁸ The court generously acknowledged that if the games had not been telecasted, or if the games were not recorded, the performance would not be fixed in tangible form, and therefore no preemption would occur.⁴⁹

The court had the audacity to suggest that the outcome in *Zacchini v. Scripps-Howard Broadcasting Co.*⁵⁰ would have been completely different if the case had been decided after section 301(a) became effective.⁵¹ That is, if the plaintiffs

³⁷ *Id.* at 665.

³⁸ *Id.* at 666.

³⁹ *Id.*

⁴⁰ 17 U.S.C. § 201(b) (2000).

⁴¹ *Balt. Orioles, Inc. v. Major League Baseball Players Ass’n*, Copyright L. Dec. (CCH) P 25,822 (N.D. Ill. 1985).

⁴² *Balt. Orioles*, 805 F.2d at 667.

⁴³ *Id.* at 670 (citing 1 M. MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT, § 5.03[D] (1985)).

⁴⁴ *Id.* at 674.

⁴⁵ *Id.*

⁴⁶ *Id.* at 675.

⁴⁷ *Id.*

⁴⁸ *Id.*

⁴⁹ *Id.*

⁵⁰ *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562 (1977).

⁵¹ 17 U.S.C. § 301(a) (2000).

performance had been captured by videotape or some other fixed medium. The court acknowledged that plaintiff's permission is necessary for videotaping to occur; however, once permission is given to anyone, and once the videotape or other fixed medium records the performance, anyone can use that videotape, or any portion thereof, with impunity, as long as he or she has the permission of the copyright holder, whether or not the copyright holder is the performer.⁵²

The Players contended that their performances were not copyrightable (by the Clubs) because the performances lacked sufficient creativity.⁵³ The court noted that, as long as a "work" fits within one of the general subject matter categories of Section 102 and 103,⁵⁴ Section 301(a)⁵⁵ prevents the states from protecting a work even if it "fails to achieve Federal copyright because it is too minimal or lacking in originality to qualify."⁵⁶ The court concluded that Section "301(a) preempts all equivalent state-law rights claimed in any work within the subject matter of copyright whether or not the work embodies any creativity."⁵⁷

The court noted an exception to its preemption presumption.⁵⁸ The court indicated that one's "right of publicity in his name or likeness would not be preempted if a company, without the consent of the player, used the player's name to advertise its product, placed the player's photograph on a baseball trading card, or marketed a game based upon the player's career statistics."⁵⁹

The court then analyzed Section 106 to determine whether or not the Players' rights of publicity were violated by any of the rights set forth in Section 106 of the Copyright Act.⁶⁰ The court began its analysis by discussing (in a footnote) that when Section 301 was first proposed it contained a list of causes of action that were, according to the Legislature, not "equivalent" to a copyright.⁶¹

That list included breaches of trust, invasion of privacy, deceptive trade practices including passing off and false representations, misappropriation, breaches of contract, trespass, conversion, and defamation.⁶² However, in response to objections by the Department of Justice, the provision was deleted "in a last-minute

⁵² *Balt. Orioles*, 805 F.2d at 675.

⁵³ *Id.* at 676.

⁵⁴ 17 U.S.C. §§ 102–103 (2000).

⁵⁵ *Id.* § 301(a).

⁵⁶ H.R. REP. NO. 94–1476 (1976), reprinted in 1976 U.S. Code Cong. & Ad. News 5659, 5747.

⁵⁷ *Balt. Orioles*, 805 F.2d at 676. The court noted that the reason for which § 301(a) preempts state law claims based upon works that "lack sufficient creativity to be copyrightable is to prevent the states from granting protection to works which Congress has concluded should be in the public domain." *Id.* at n.23.

⁵⁸ *Id.* at n.24.

⁵⁹ *Id.* (citing, *Cepeda v. Swift & Co.*, 415 F.2d 1205, 1206 (8th Cir. 1969); *Fleer Corp. v. Topps Chewing Gum, Inc.*, 658 F.2d 139, 148–49 (3d Cir. 1981); *Haelan Labs., Inc. v. Topps Chewing Gum, Inc.* 202 F.2d 866 (2nd Cir. 1953); *Uhlaender v. Henricksen*, 316 F. Supp. 1277, 1282 (D. Minn. 1970)). This footnote was ultimately cited by the plaintiff in *Toney* in support of her case, and in an effort to distinguish her case from *Baltimore Orioles*; the argument was rejected by the Seventh Circuit. *Toney v. L'Oreal U.S.A., Inc.*, 384 F.3d 486, 490 (7th Cir. 2004), *reh'g en banc granted*, No. 03-2184, 2005 U.S. App. Lexis 1943 (Feb. 3, 2005), *rev'd*, No. 03-2184, 2005 U.S. App. LEXIS 7897 (May 6, 2005).

⁶⁰ *Balt. Orioles*, 805 F.2d at 676.

⁶¹ *Id.* at 677 n.25.

⁶² *Id.*

amendment on the House floor.”⁶³ The court decided to ignore the language and its deletion.⁶⁴

The court then noted that the Players claimed a right of publicity in their performances, and that such a right is violated by the televised broadcast of that performance without their consent.⁶⁵ The court held the Clubs’ (copyright) right to broadcast telecasts of the games infringed the Players’ right of publicity in their performances, and the Players’ right of publicity is equivalent to at least one of the rights encompassed by copyright.⁶⁶ Therefore, the right is preempted.⁶⁷

The Players argued that their right of publicity served different interests than the rights contained in a copyright, the purpose of the former being the protection of individual pecuniary interests, and the purpose of the latter being to secure a benefit to the public.⁶⁸ The court summarily rejected the argument, stating very briefly: “[w]e disagree.”⁶⁹

The court disagreed with decisions from the Second⁷⁰ and Ninth⁷¹ Circuits, both of which found no preemption of right of publicity claims. The Seventh Circuit in *Baltimore Orioles* said that the other circuit courts’ analyses were “premised upon an erroneous analysis of preemption.”⁷² Although the other circuits found that a public figure’s persona cannot be fixed in a tangible medium of expression, the Seventh Circuit in *Baltimore Orioles* resolved the issue by holding that “a performance is fixed in tangible form when it is recorded.”⁷³

⁶³ *Id.*

⁶⁴ *Id.* (citing Copyright L. Rep. (CCH) P 7305). The court noted that

[b]ecause the House’s debate concerning the effect of the amendment is ambiguous, if not contradictory, and because the Senate concurred without discussion in the House’s version of § 301, almost any interpretation of the concept of equivalent rights can be inferred from the legislative history. Therefore, in determining whether a particular right is equivalent to a copyright, we place little weight on the deletion of the list of nonequivalent rights.

Id.

⁶⁵ *Id.* at 677.

⁶⁶ *Id.*

⁶⁷ *Id.*

⁶⁸ *Id.* at 677–78.

⁶⁹ *Id.*

⁷⁰ *Factors Etc., Inc. v. Pro Arts, Inc.*, 652 F.2d 278, 289 (2d Cir. 1981), *cert. denied*, 456 U.S. 927 (1982).

⁷¹ *Bi-Rite Enters., Inc. v. Button Master*, 555 F. Supp. 1188 (S.D.N.Y. 1983).

⁷² *Balt. Orioles, Inc. v. Major League Baseball Players Ass’n*, 805 F.2d 663, 678 n.26 (7th Cir. 1986).

⁷³ *Id.* The court went on to discuss the Clubs’ master-servant claim, i.e., that, under Illinois master-servant law, the Clubs would also have the exclusive right to broadcast the game. *Id.* at 681–82. In its discussion of which state’s law would apply to the master-servant claim, the court analyzes, at length, conflict of law issues and the options of a district court sitting in diversity. *Id.* at 681. The court ultimately determined that it could not determine which state governed the Clubs’ master-servant claim, but left it to the district court to determine on remand. *Id.* In doing so, the court also made it clear to the district court that the master-servant claim was *pendant* to the copyright claim, and reminded the district court that it could simply dismiss the pendant claims once the federal claims (which it was in the process of determining) were determined. *Id.* at 682. The court directed the district court to “exercise its discretion in the first instance in light of the above principles.” *Id.*

However, the Seventh Circuit failed to understand that performance is just an indicia of an individual's—particularly a public figure's—*persona*, and that the only reason to construe such a *performance* right to be part of a right of publicity is because it bears on the individual's *persona* (which is the crux of right of publicity law), just as his or her name, likeness, voice or anything else that is closely associated with that individual (such as a distinctive uniform, hat, or car) might.

The *Baltimore Orioles* court found that the Players had “attempted to obtain *ex post* what they did not negotiate *ex ante*,” i.e., that they sought a judicial determination that they had the right to control the telecasts of major league baseball games long after they had failed to obtain such rights when they negotiated their collective bargaining agreement.⁷⁴ In light of the foregoing statement, it is apparent that the court engaged in its tortured analysis of right of publicity law and the law of copyright preemption so that the Players would not get “something for nothing.”

III. *TONEY V. L'OREAL U.S.A., INC.*⁷⁵

June Toney was a print, commercial and runway model who entered into a contract with Johnson Products Company (not a defendant) whereby she authorized Johnson to use her likeness on the packaging of a hair-relaxer product called “Ultra Sheen Supreme” for a five-year period.⁷⁶ In that agreement, Toney also authorized Johnson to use her likeness in national magazine advertisements for “Ultra Sheen” for roughly the same period.⁷⁷ The defendants continued to use her likeness in connection with the packaging and promotion of the product beyond the authorized time period.⁷⁸

Toney sued the defendants in state court, asserting two causes of action: (i) a violation of her right to publicity in her likeness, as protected under the Illinois Right of Publicity Act⁷⁹ (the “IRPA”); and (ii) a violation of the Lanham Trademark Act of 1946.⁸⁰ The defendants removed the case to federal district court on the basis of

⁷⁴ *Id.* at 679.

⁷⁵ *Toney v. L'Oreal U.S.A., Inc.*, 384 F.3d 486, 490 (7th Cir. 2004), *reh'g en banc granted*, No. 03-2184, 2005 U.S. App. Lexis 1943 (Feb. 3, 2005), *rev'd*, No. 03-2184, 2005 U.S. App. LEXIS 7897 (May 6, 2005).

⁷⁶ *Id.* at 487.

⁷⁷ *Id.* at 487–88.

⁷⁸ *Id.* at 488.

⁷⁹ 765 ILL. COMP. STAT. 1075/1–/60 (2003) [hereinafter IRPA].

⁸⁰ 15 U.S.C. § 1125(a) (2000). The court, for some reason, mentioned several times in its opinion, that the plaintiff never asserted a cause of action for breach of contract in its complaint. *Toney*, 384 F.3d at 490, 492. However, the court did not say that such a claim, like the right of publicity claim, would *not* be preempted. In fact, the court indicated, based on the same Circuit's analysis of *Cepeda v. Swift & Co.*, 415 F.2d 1205 (8th Cir. 1969) in *Baltimore Orioles*, “a common law contract action may or may not be preempted (under § 301 or otherwise), and that a case-by-case preemption analysis is necessary.” *Toney*, 384 F.3d at 491. Of course, the aforementioned statement was made by the court in the same paragraph in which it stated, not only that “*Cepeda* was decided in 1969 and § 301 of the Copyright Act did not take effect until January 1, 1978,” and that “only implied preemption could have possibly been at issue in that case,” but also that “*Cepeda* did not consider any preemption issue at all, implied or otherwise.” *Id.* at 490. It is difficult to understand. If the *Cepeda* court did not consider any preemption issues at all, how could

federal question jurisdiction, and immediately filed a Rule 12(b)(6) motion to dismiss.⁸¹

The District Court found that the IRPA-based right of publicity claim met the conditions set forth in Section 301 of the Copyright Act, and was therefore preempted by the Act.⁸² Toney later voluntarily dismissed her Lanham Act claim with prejudice, and the case was dismissed.⁸³ The sole issue raised on appeal was whether the plaintiff's IRPA claim was preempted by the Copyright Act.

The Seventh Circuit began its analysis by discussing the IRPA, noting that the IRPA gives an individual the "right to control and to choose whether and how to use an individual's identity for commercial purposes."⁸⁴ The IRPA also provides that "[a] person may not use an individual's identity for commercial purposes during the individual's lifetime without having obtained previous written consent from the appropriate person . . . or their authorized representative."⁸⁵

The court then delved into a discussion of section 301 of the Copyright Act, subsection (a):

On and after January 1, 1978, all legal or equitable rights that are equivalent to any of the exclusive rights within the general scope of copyright as specified by section 106 in works of authorship that are fixed in a tangible medium of expression and come within the subject matter of copyright as specified by sections 102 and 103 . . . are governed exclusively by this title. Thereafter, no person is entitled to any such right or equivalent right in any such work under the common law or statutes of any State.⁸⁶

The court discussed the two elements of preemption: (i) "the work in which the right is asserted must be fixed in tangible form and come within the subject matter of copyright as specified in § 102;"⁸⁷ and (ii) "the right must be equivalent to any of the rights specified in § 106."⁸⁸

In its analysis of the preemption issue, as applied to *Toney*, the court noted that the plaintiff's likeness in photographic form "is an original work and fixed in tangible form (as no one photo of Toney is exactly like another . . .)."⁸⁹ It also noted that section 101 include photographs as pictorial works.⁹⁰ On those bases, the court

Toney could possibly have held that preemption issues in contract cases must be determined on a case-by-case basis? *Id.* at 491.

⁸¹ *Toney*, 384 F.3d at 488.

⁸² *Toney v. L'Oreal USA, Inc.*, No. 02-C3002, 2002 U.S. Dist. LEXIS 21229 (N.D. Ill. 2002), *aff'd*, 384 F.3d 486 (7th Cir. 2004).

⁸³ *Id.* at 488. It is not clear the reason for which the plaintiff dismissed this claim. Right of publicity claims in federal court are routinely brought successfully under the Lanham Act.

⁸⁴ *Toney*, 384 F.3d at 488 (citing IRPA § 1075/10).

⁸⁵ *Id.* at 488 (citing IRPA §1075/30).

⁸⁶ *Id.* at n.1 (quoting 17 U.S.C. § 301(a) (2000)).

⁸⁷ *Toney*, 384 F.3d at 488–89 (citing *Balt. Orioles, Inc. v. Major League Baseball Players Ass'n*, 805 F.2d 663, 674 (7th Cir. 1986)).

⁸⁸ *Id.*

⁸⁹ *Id.* at 489.

⁹⁰ *Id.*

determined that “the photographs of Toney’s likeness are the subject matter of copyright, and that the ‘Section 102 condition’ has therefore been met.”⁹¹

Although the plaintiff argued that her IRPA claim was actually directed at the defendants’ use of her *identity*, as opposed to simply her “likeness fixed in photographic form,” the court found such an argument barred/waived because the plaintiff did not use the word “identity” in her original complaint.⁹² However, the court did not indicate whether or not it would have changed its finding if the plaintiff had actually used the word “identity” in the complaint.

The plaintiff did make an argument to the District Court that her IRPA claim was based upon her right of publicity in her likeness, as opposed to her likeness in photographic form.⁹³ Although the plaintiff apparently abandoned that argument before the Seventh Circuit, the court did address the argument, immediately rejecting it.⁹⁴

Staying in line with its *Baltimore Orioles* decision, the court determined, for the purposes of preemption, that there is no “distinction between the content of the publicity rights and the artistic—and thus obviously copyrightable—product resulting from the photographic (or filmic) recording of someone’s likeness (or performance).”⁹⁵ In other words, one cannot, for the purposes of a preemption analysis, distinguish between the unlawful use of one’s likeness (which is a violation of one’s right of publicity) and the unlawful use of a fixed medium (such as a photograph) depicting that likeness (which is a violation of the Copyright Act).

The court did note, however, that Nimmer completely disagrees with that concept. Nimmer asserts that, merely because one’s likeness happens to be embodied in a copyrightable work, the likeness itself does not become a work of authorship within the exclusive subject matter of copyright.⁹⁶

The court seemed to go out of its way to note that the plaintiff “did not anywhere suggest that we should reconsider *Baltimore Orioles* . . .”⁹⁷ What the plaintiff did do was to find language in *Baltimore Orioles* that seemed to support its case.⁹⁸ The court in *Baltimore Orioles*, in a footnote, appeared to limit preemption depending on whether or not the likeness was used to endorse a product, noting “[a] player’s right to publicity in his name or likeness would not be preempted if a company, without the consent of the player, used the player’s name to advertise its product.”⁹⁹ However, the *Toney* court rejected the plaintiff’s request to apply this notion to the

⁹¹ *Id.*

⁹² *Id.*

⁹³ *Id.*

⁹⁴ *Id.*

⁹⁵ *Id.* (citing *Balt. Orioles*, 805 F.2d at 674–76).

⁹⁶ 1 NIMMER, *supra* note 43, § 1.01[B][1][c] (2004); see *Downing v. Abercrombie & Fitch*, 265 F.3d 994, 1003–34 (9th Cir. 2001); see also *Brown v. Ames*, 201 F.3d 654, 658–89 (5th Cir. 2000).

⁹⁷ *Toney v. L’Oreal U.S.A., Inc.*, 384 F.3d 486, 490 (7th Cir. 2004), *reh’g en banc granted*, No. 03-2184, 2005 U.S. App. Lexis 1943 (Feb. 3, 2005), *rev’d*, No. 03-2184, 2005 U.S. App. LEXIS 7897 (May 6, 2005). The court, by mentioning, more than once, that the plaintiff did not request the court to disregard or reconsider its holding in *Baltimore Orioles*, seems to have wanted the plaintiff to do that very thing. *Id.* The court appears to feel constrained by the case; however, ultimately, the court goes further than even *Baltimore Orioles* did.

⁹⁸ *Id.*

⁹⁹ *Balt. Orioles*, 805 F.2d at 676, n.24.

Toney case.¹⁰⁰ The court admitted that “a casual reading” of that language appears to support the plaintiff’s position that her likeness is not within the subject matter of copyright, and therefore, the plaintiff’s right of publicity claim is not preempted.¹⁰¹ While the court concluded that “*Toney* is mistaken,”¹⁰² the explanation of why *Toney* was “mistaken” is as confusing as the holding itself.

IV. VARYING ANALYSES OF RIGHTS UNDER § 106

A. *The Toney Court*

The *Toney* court next examined the specific rights enumerated by section 106 of the Copyright Act¹⁰³ in order to ascertain whether or not the IRPA protected any of the same rights. Section 106 provides that

the owner of copyright under this title has the exclusive rights to do and to authorize any of the following: (i) to reproduce the copyrighted work in copies or phonorecords; (ii) to prepare derivative works based upon the copyrighted work; (iii) to distribute copies or phonorecords of the copyrighted work to the public by same or other transfer of ownership, or by rental, lease, or lending; (iv) in the case of literary, musical, dramatic, and choreographic works, pantomimes, and motion pictures and other audiovisual works, to perform the copyrighted work publicly; (v) in the case of literary, musical, dramatic, and choreographic works, pantomimes, and pictorial, graphic, or sculptural works, including the individual images of a motion picture or other audiovisual work, to display the copyrighted work publicly; and (vi) in the case of sound recordings, to perform the copyrighted work publicly by means of a digital audio transmission.¹⁰⁴

The *Toney* court described these “five exclusive and fundamental rights” as: “reproduction, adaptation, publication, performance, and display.”¹⁰⁵ The court noted that a state law is preempted by the Copyright Act if the state law is violated by an act that would also amount to copyright infringement.¹⁰⁶ In other words, to prevent preemption, the “state law must regulate conduct qualitatively distinguishable from that governed by federal copyright law—i.e. conduct other than reproduction, adaptation, publication, performance, and display.”¹⁰⁷

¹⁰⁰ *Toney*, 384 F.3d at 490.

¹⁰¹ *Id.*

¹⁰² *Id.*

¹⁰³ 17 U.S.C. § 106 (2000).

¹⁰⁴ *Id.*

¹⁰⁵ *Toney*, 384 F.3d at 491.

¹⁰⁶ *Id.* (citing *Balt. Orioles, Inc. v. Major League Baseball Players Ass’n*, 805 F.2d 663, 677 (7th Cir. 1986)).

¹⁰⁷ *Id.*; *Trandes Corp. v. Guy F. Atkinson Co.*, 996 F.2d 655, 659–60 (4th Cir. 1993) (citing *Harper & Row Publishers, Inc. v. Nation Enters.*, 723 F.2d 195, 200–01 (2d Cir. 1983), *rev’d on other grounds*, 471 U.S. 539 (1985); 1 NIMMER, *supra* note 43, § 1.01[B][1]).

The *Toney* court acknowledged that “some courts” use a different test in determining preemption issues.¹⁰⁸ The court referred to an “elements test,” which provides that if the state law contains elements that, are in addition to those necessary to state a claim for copyright infringement (*i.e.*, “extra elements”), there is no preemption.¹⁰⁹ However, the *Toney* court effectively rejected that test by maintaining that not every word in a state law rises to the level of an “element,” and that the “focus” must be on the big picture of “whether the right protected under state law addresses conduct qualitatively different from that which the Copyright Act speaks to [*sic*]”.¹¹⁰

The court then analyzed whether the IRPA is qualitatively indistinguishable from section 106.¹¹¹ The court’s phrasing of the issue makes the outcome a foregone conclusion. The court described the plaintiff’s claim as one for “right of publicity in her likeness in photographic form,” having determined that the plaintiff had not used the word “identity” in her complaint, and was therefore precluded from arguing that the photograph was an expression of her identity, rather than the expression of copyright rights.¹¹²

The court, without any discernable analysis, found that: “Toney’s right of publicity in her likeness in photographic form protected under the IRPA is qualitatively indistinguishable from the rights enumerated in § 106 of the Copyright Act. Toney’s right to publicity prohibits the unauthorized reproduction, adaptation, publication, or display of her photos.”¹¹³

The court held that, because the plaintiff did not hold the copyright to any of the photographs—the employer of the photographer did—and because the exercise of that copyright holder’s rights to reproduce, adapt, publish, or display the photographs would also infringe upon the plaintiff’s “right to publicity in her likeness in photographic form,” such right was preempted by the Copyright Act.¹¹⁴

The court went on to say that, irrespective of who holds the copyright in her photographs, there is “no meaningful distinction” between the state law rights asserted by the plaintiff and the rights protected under the Copyright Act. The district court’s dismissal of the IRPA claim was therefore affirmed by the Seventh Circuit.¹¹⁵

B. The Law in Other Circuits

The law in the Seventh Circuit is decidedly different than in other circuits. For instance, the Ninth Circuit interprets the word “likeness” to be more than just someone’s face depicted in a photograph, drawing or sculpture; in fact, the Ninth

¹⁰⁸ *Toney*, 384 F.3d at 491.

¹⁰⁹ *Id.*

¹¹⁰ *Id.*

¹¹¹ *Id.*

¹¹² *Id.*

¹¹³ *Id.* at 492.

¹¹⁴ *Id.* (citing *Balt. Orioles, Inc. v. Major League Baseball Players Ass’n*, 805 F.2d 663, 679 (7th Cir. 1986)).

¹¹⁵ *Id.*

Circuit presupposes that a “likeness,” by its nature, cannot be “fixed in a tangible medium of expression” in the first place.¹¹⁶

In *Downing v. Abercrombie & Fitch*, the plaintiffs were professional surfers depicted in a photograph that was taken in 1965, in Hawaii.¹¹⁷ Abercrombie & Fitch, a well-known clothing manufacturer, had acquired the rights to the photographs from the original photographer, and included them in its quarterly clothing catalog along with some articles about surfing.¹¹⁸ The plaintiffs sued, claiming that the clothing manufacturer had violated their rights of publicity by misappropriating their likenesses.¹¹⁹ The District Court held that their publicity rights under state law were preempted by the Copyright Act.¹²⁰

The Ninth Circuit disagreed, and reversed the District Court’s dismissal of the action.¹²¹ The court started with the same analysis as that used by the Seventh Circuit, noting that section 301 expressly prohibits the states from legislating in the area of copyright law, and that, in order to find preemption, two conditions must be met.¹²² First, the “content of the protected right must fall within the subject matter of copyright as described in 17 U.S.C. §§ 102 and 103.”¹²³ Second, the right asserted under state law must be equivalent to the exclusive rights contained in section 106 of the Copyright Act.¹²⁴

Like the Seventh Circuit, the Ninth Circuit examined section 102 to determine “the subject matter” that is protected by the Act.¹²⁵ Section 102 provides that:

Copyright protection subsists . . . in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device. Works of authorship include . . . pictorial, graphic, and sculptural works.¹²⁶

However, the Ninth Circuit noted that the copyright in such works extends only to the material contributed by the author of such works, as distinguished from the preexisting material employed in the work.¹²⁷

The *Downing* court, like the *Toney* court, noted that the photograph in question (in this case, depicting the surfers) was itself a pictorial work of authorship protected by the Copyright Act.¹²⁸ However, unlike the *Toney* court, the *Downing* court ruled that the publication of the photograph itself was not the basis of the surfers’ claims;

¹¹⁶ *Downing v. Abercrombie & Fitch*, 265 F.3d 994 (9th Cir. 2001).

¹¹⁷ *Id.* at 999.

¹¹⁸ *Id.*

¹¹⁹ *Id.*

¹²⁰ *Id.*

¹²¹ *Id.*

¹²² *Id.* at 1003.

¹²³ *Id.*

¹²⁴ *Id.*

¹²⁵ *Id.*

¹²⁶ 17 U.S.C. § 102(a)(5) (2000).

¹²⁷ *Downing*, 265 F.3d at 1003.

¹²⁸ *Id.* at 1004.

the basis of their claims, according to the court, was Abercrombie's use of their *names and likenesses* in the published photograph.¹²⁹

The court cited both Nimmer and McCarthy to explain the relationship between the right of publicity and copyright. According to Nimmer:

[T]he "work" that is the subject matter of the right of publicity is the persona, i.e., the name and likeness of a celebrity or other individual. A persona can hardly be said to constitute a "writing" of an "author" within the meaning of the copyright clause of the Constitution. *A fortiori* it is not a "work of authorship" under the Act. Such name or likeness does not become a work of authorship simply because it is embodied in a copyrightable work such as a photograph.¹³⁰

Similarly, McCarthy provides the following with respect to right of publicity claims:

The "subject matter" of a Right of Publicity claim is not a particular picture or photograph of plaintiff. Rather, what is protected by the Right of Publicity is the very identity or persona of the plaintiff as a human being While copyright in a given photograph may be owned by the person depicted in it, the exact image in that photograph is not the underlying "right" asserted in a Right of Publicity case. To argue that the photograph is identical with the person is to confuse illusion and illustration with reality. Thus, assertion of infringement of the Right of Publicity because of defendant's unpermitted commercial use of a picture of plaintiff is not assertion of infringement of copyrightable "subject matter" in one photograph of plaintiff.¹³¹

The Ninth Circuit then conducted an analysis of whether or not the right of publicity that was asserted by the surfers was equivalent to the exclusive rights in section 106 of the Act.¹³² According to the court, notwithstanding the fact that photographs on which one's likeness is depicted are copyrightable, the underlying names and likenesses are not copyrightable.¹³³ The court held that, because the surfers' statutory and common law right of publicity claims were based upon their names and likenesses, those claims were not equivalent to the exclusive rights contained in section 106 of the Act,¹³⁴ and therefore there was no preemption.¹³⁵

Similarly, in *Grosso v. Miramax*,¹³⁶ the Ninth Circuit, in a breach of implied contract setting, citing *Del Madera Props. v. Rhodes & Gardner, Inc.*,¹³⁷ held that in order to avoid preemption the state law claim must include an "extra element" that

¹²⁹ *Id.*

¹³⁰ *Id.* at 1003–04 (quoting 1 NIMMER, *supra* note 43, § 1.01[B][1][c], at 1–23 (1999)).

¹³¹ *Id.* at 1004 (quoting 1 MCCARTHY, *supra* note 22, § 11.13[C], at 11-72–73 (1997)).

¹³² *Id.*

¹³³ *Id.*

¹³⁴ *Id.* at 1005.

¹³⁵ *Id.* at 1010.

¹³⁶ *Grosso v. Miramax Film Corp.*, 383 F.3d 965 (9th Cir. 2004).

¹³⁷ *Del Madera Prop. v. Rhodes & Gardner, Inc.*, 820 F.2d 973 (9th Cir. 1987).

“transforms the action from one arising under the ambit of the federal statute to one sounding in contract.”¹³⁸

The Second Circuit has also adopted the “extra element” test.¹³⁹ In *Briarpatch Limited, L.P., v. Phoenix Pictures, Inc.*, the Second Circuit had the occasion to decide whether or not an unjust enrichment claim and a breach of fiduciary duty claim are preempted by the Copyright Act.¹⁴⁰ Briarpatch, a limited partnership, sued a corporation owned by two of the owners of general partner corporations of Briarpatch for breach of fiduciary duty and unjust enrichment based upon the individuals’ sale of the motion picture rights to a novel entitled “The Thin Red Line” to Defendant Phoenix Pictures.¹⁴¹

The Second Circuit, like the Ninth Circuit, adopted the “extra elements” test in determining whether the state claims were qualitatively different from a copyright claim, and therefore preempted.¹⁴² Although the court purported to “take a restrictive view of what extra elements transform an otherwise equivalent claim into one that is qualitatively different from a copyright infringement claim,” noting that a state requirement of awareness or intent would not constitute such an “extra element,” it did note that a “state law claim is qualitatively different if it requires such elements as breach of fiduciary duty . . . or possession or control of chattels.”¹⁴³

The court ultimately held that the unjust enrichment claim was preempted because that claim was not qualitatively different from a copyright infringement claim, *i.e.*, that the alleged extra element, enrichment, like the elements of awareness or intent, “limits the scope of the claim but leaves its fundamental nature unaltered.”¹⁴⁴ However, the court held that there was no copyright preemption with respect to the breach of fiduciary duty claims because the underlying right sought to be redressed was the “violations of the duty owed to a partnership by those who control it.”¹⁴⁵

Although the *Briarpatch* case did not involve a state law right of publicity claim, and there appear to be no other federal cases in New York that address the issue, it is clear from the Second Circuit’s analysis in *Briarpatch* that it would not find preemption in such a case.

Similarly, the Appellate Division of the New York Supreme Court, in *Molina v. Phoenix Sound Inc.*,¹⁴⁶ specifically held that New York’s right of publicity law was not preempted because the “statute contains the additional element of use of one’s image for advertising or trade purposes without written consent”¹⁴⁷

¹³⁸ *Grosso*, 383 F.3d at 968.

¹³⁹ *Briarpatch Ltd., L.P. v. Phoenix Pictures, Inc.*, 373 F.3d 296 (2d Cir. 2004).

¹⁴⁰ *Id.* at 300.

¹⁴¹ *Id.*

¹⁴² *Id.* at 305 (citing *Nat’l Basketball Ass’n v. Motorola, Inc.*, 105 F.3d 841, 851 (2d Cir. 1997)).

¹⁴³ *Id.* at 306 (citing *Harper & Row Publishers, Inc. v. Nation Enters.*, 723 F.2d 195, 201 (2d Cir. 1983), *rev’d on other grounds*, 471 U.S. 539 (1985)).

¹⁴⁴ *Id.* at 306.

¹⁴⁵ *Id.* at 307.

¹⁴⁶ *Molina v. Phoenix Sound Inc.*, 747 N.Y.S.2d 227 (N.Y. App. Div. 2002).

¹⁴⁷ *Id.* at 598–89 (citing *Mayer v. Josiah Wedgwood & Sons, Ltd.*, 601 F. Supp. 1523, 1535 (S.D.N.Y. 1985); *Shamsky v. Garan, Inc.*, 167 Misc. 2d 149 (N.Y. Sup. Ct. 1995); *James v. Delilah Films*, 144 Misc. 2d 374 (N.Y. Sup. Ct. 1989)).

C. Nimmer

Nimmer also adopts the “extra element” test:

Abstracting to the realm of principle, if under state law the act of reproduction, performance, distribution, or display, no matter whether the law includes all such acts or only some, will *in itself* infringe the state-created right, then such right is pre-empted. But if qualitatively other elements are required, instead of, or in addition to, the acts of reproduction, performance, distribution, or display, in order to constitute a state-created cause of action, then the right does not lie “within the general scope of copyright,” and there is no pre-emption.¹⁴⁸

In other words, if the elements of the state-created law are the exactly the same as one or more of the elements necessary to prove copyright infringement, then that law is preempted. However, if the state law requires one or more additional elements that are not required to prove copyright infringement, there is no preemption.

In the context of right of publicity, the “extra element” would arguably be both the use of the plaintiff’s likeness or *persona*, and a requirement that such use be for endorsement purposes. Of course, one could argue that such a test would effectively preclude a state-created right of publicity from ever being preempted by the Copyright Act. However, such a result makes much more sense and has a much more rational basis than the result in *Toney*.

It is not difficult to understand why Congress would not want the states to encroach on its own constitutionally-mandated area, *i.e.*, the protection of intellectual property. However, it is much more difficult to imagine that Congress intended to prohibit every possible state cause of action that involved the use of that intellectual property.

V. CRITICISM/RAMIFICATIONS OF *TONEY*

The *Toney* court had the temerity to note, in a footnote, that: “even if a work is too minimal or lacking in originality to qualify for Federal copyright, so long as it meets the requirements of § 301, states are nonetheless prevented from protecting the work.”¹⁴⁹ The practical effect of this footnote is that, in certain circumstances, one can steal both copyright-protected material and someone’s likeness, and profit from both, with complete impunity.

The actual holding in *Baltimore Orioles* makes some sense (even if the rationale does not) to the extent that the use at issue was not an endorsement of a product, but merely a depiction of the very activity in which the plaintiffs were paid to engage,

¹⁴⁸ 1 NIMMER, *supra* note 43, § 1.01[B][1] (endnotes omitted).

¹⁴⁹ *Toney v. L’Oreal U.S.A., Inc.*, 384 F.3d 486, 490 (7th Cir. 2004), *reh’g en banc granted*, No. 03-2184, 2005 U.S. App. Lexis 1943 (Feb. 3, 2005), *rev’d*, No. 03-2184, 2005 U.S. App. LEXIS 7897 (May 6, 2005) (citing *Balt. Orioles, Inc. v. Major League Baseball Players Ass’n*, 805 F.2d 663, 676 (7th Cir. 1986); H.R. REP. NO. 94-1476 (1976), *reprinted in* 1976 U.S. Code Cong. & Ad. News 5659, 5747.).

i.e., playing baseball. The Seventh Circuit in that case makes it clear that the players' right of publicity claim would not have been preempted if the player's name or likeness had been used to advertise a product.¹⁵⁰

In *Toney*, the Seventh Circuit seemed to criticize the plaintiffs' counsel for not asking the court to "reconsider" its decision in *Baltimore Orioles*, having mentioned this failure on more than one occasion. However, after this apparent criticism, the court actually expands the holding in that case to require preemption even when the offending use is an endorsement of a product.

In short, the *Toney* decision makes no sense whatsoever, and remains an anomaly in the federal circuits. The ramifications of *Toney* are fairly obvious. According to *Toney*, what has been referred to for over 100 years as "misappropriation of name and likeness" should now be referred to, at best, as "misappropriation of name and simulated voices." In fact, an argument could be made that, under *Toney*, there is no right of publicity left at all.

First, if one's name is depicted in or on copyrighted material, presumably the law precluding the use of the name would also be preempted. Similarly, although the *Toney* court specifically mentions sound-a-like voice misappropriation, an argument could be made that the misappropriation of someone's voice, even by a sound-a-like, must necessarily involve a copyrightable recording of that voice. Because the recording of the voice is copyrightable, and the performance or display of the recording would be both a violation of plaintiff's right of publicity and an infringement of the copyright holder's copyright, the voice misappropriation part of right of publicity law would also be preempted. Effectively, the Seventh Circuit appears to have single-handedly, completely eviscerated the law of right of publicity in one fell swoop.

Nimmer apparently agrees with the other circuits that, merely because one's likeness happens to be embodied in a copyrightable work does not render the likeness itself a work of authorship within the exclusive subject matter of copyright.¹⁵¹ Any contrary holding, like *Toney*, would leave the states in complete chaos. The deplorable ramifications of the decision are myriad.

In the Seventh Circuit, after *Toney*, anyone may use any actor's photograph to endorse their product if they make a deal with the photographer (irrespective of whether or not the actor authorized the taking of the photograph, such as any random paparazzi). Moreover, anyone may use a *de minimus* movie clip of any actor to endorse their product with complete impunity, whether or not they make a deal with the filmmaker.

Anyone may purchase from a still or motion picture photographer a surreptitiously-taken nude photograph or motion picture of an actress and insert the clip into a pornographic film. Anyone may use the same photograph to advertise a strip club, brothel or any other service or product. Anyone may use a photograph that includes the depiction of otherwise defamatory words with impunity, merely by paying the photographer for the rights to the photograph.

Certainly, the *Toney* holding is not limited to photographs or film. Anything that is generally copyrightable seems to be fair game, such as drawings, paintings,

¹⁵⁰ *Balt. Orioles*, 805 F.2d at 676 n.24.

¹⁵¹ 1 NIMMER, *supra* note 43, § 1.01[B][1][c]; *Downing v. Abercrombie & Fitch*, 265 F.3d 994, 1003–04 (9th Cir. 2001); *Brown v. Ames*, 201 F.3d 654, 658–59 (5th Cir. 2000).

animations, sculptures, and recordings.¹⁵² Moreover, the holding is certainly not limited to right of publicity laws alone. First, as the nude photograph example makes clear, the intrusion and public disclosure of private facts right of privacy torts are also in serious jeopardy.

Moreover, a logical extension of *Toney* might actually prevent a state from enacting a law that would prohibit or otherwise regulate pornography or even obscenity unless such pornography or obscenity was live, and not depicted in a copyrightable medium such as a photograph or film.¹⁵³ Although this example is extreme, there is nothing in the *Toney* opinion that would suggest that such an outcome could not occur.

Another logical extension of *Toney* would be that any state law allowing the loud performance of music or the performance of music after a certain hour would also be preempted. Certainly, litter laws or solicitation laws prohibiting the display of copyrighted photographs would be preempted, as would state laws prohibiting the theft of photographs, recordings, films, sculptures or any other copyrightable materials. Presumably, state laws prohibiting the surreptitious recording of a telephone conversation or other confidential communication, and the subsequent use of that recording in court or otherwise, would be preempted as well.

In addition, state laws making a breach of an express or implied¹⁵⁴ contract unlawful may certainly be preempted when the contract at issue is one concerning a copyrightable work such as a contract to *reproduce, distribute, or display* articles, books, magazines, musical recordings, musical compositions, paintings, sculptures, and other copyrightable “works,” as well as laws making it unlawful to interfere with such contracts.

VI. CONCLUSION

Two things have been made clear by the Seventh Circuit’s decision in *Toney*: (i) the decision is a dangerous anomaly that is potentially devastating to the very industry that the Copyright Act was designed to protect; and (ii) if the *Toney* decision is not overturned upon rehearing, the United States Supreme Court *must* take action

¹⁵² 17 U.S.C. § 102 (2000). Section 102(a) provides:

Copyright protection subsists . . . in original works of authorship fixed in any tangible medium of *expression*, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device. Works of authorship include the following categories: (1) literary works; (2) musical works, including any accompanying words; (3) dramatic works, including any accompanying music; (4) pantomimes and choreographic works; (5) pictorial, graphic, and sculptural works; (6) motion pictures and other audiovisual works; and (7) sound recordings.

Id.

¹⁵³ Even in that case, if the performers claimed ownership in the choreography, such live broadcast might also be preempted.

¹⁵⁴ See *generally* *Grosso v. Miramax*, 383 F.3d 965 (9th Cir. 2004). In the Ninth Circuit, an action for breach of an implied contract is not preempted because such a claim involves the requisite “extra element” of an implied promise to pay the reasonable value of the “services of conveying [an] idea.” *Id.* at 967–68 (citing *Landsberg v. Scrabble Crossword Game Players, Inc.*, 802 F.2d 1193, 1196–97 (9th Cir. 1986)).

immediately to resolve the conflict among the circuits with respect to the possible preemption of numerous state civil and criminal laws that are vital to the nation as a whole.